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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,801	04/06/2001	Murali Rajagopalan	20002.0088	5361
23517 7590 10/22/2007 BINGHAM MCCUTCHEN LLP 2020 K Street, N.W. Intellectual Property Department WASHINGTON, DC 20006			EXAMINER CHEN, VIVIAN	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 10/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/827,801	RAJAGOPALAN, MURALI	
	Examiner	Art Unit	
	Vivian Chen	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-13, 15-17, 22-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

claims 1-34 of U.S. Patent No. 5,962,140,

in view of ENDO (US 5,586,950).

U.S. Patent No. 5,962,140 claims a golf ball comprising at least one intermediate layer (equivalent to the claimed "cover layer" and "coating layer") comprising a functionalized fluoropolymer as recited in application claims 1, 7-11 (e.g., patent claim 1, 7-8, 11), and further claims at least one intermediate layer comprising a fluorinated terpolymer having the structure as recited in application claims 6 (e.g., patent claim 4). The fluoropolymer and terpolymers are optionally blended with an additional component including ionomeric and non-ionomeric polymers. (e.g. patent claim 2)

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ENDO ET AL discloses that it is well known in the art to use multiple cover layers composed of similar types of resin in golf ball construction in order to obtain a desirable balance of playing 'feel', hitting and flight characteristics and durability. (Figure 1; column 1)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use multiple intermediate layers of the functionalized fluoropolymer or terpolymer polymer claimed in U.S. Patent No. 5,962,140 in order to optimize the durability, and mechanical and/or flight characteristics of the ball for various playing styles or player skill levels. One of ordinary skill in the art would have selected the relative amounts of the additional component and fluoropolymer (or terpolymer) (application claims 12, 17, 21) in order to obtain specific mechanical and/or elastic properties (e.g., stiffness, hardness, etc.) to provide the desired playing characteristics for the ball.

3. Claim 14, 18-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

claims 1-34 of U.S. Patent No. 5,962,140

as applied to claims 1, 5 above,

and further in view of HIGUCHI ET AL (US 5,702,311)

HIGUCHI ET AL discloses that it is well known in the art to use multilayer core structures in the formation of golf balls to optimize the playing characteristics of the ball. (Figure 1A-1B; line 35-50, col. 1). The reference also discloses that it is conventional to apply covering layers to a golf ball core by molding a covering layer material onto the core. (line 26-31, col. 4)

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional multilayer construction and techniques to form the cores of the coated golf balls disclosed in MORGAN ET AL or CHAPMAN, JR ET AL in order to optimize the mechanical and/or flight characteristics of the ball for various playing styles

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 7, 9, 11, 13, 22, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

(a) MORGAN ET AL (US 5,397,829), or

(b) CHAPMAN, JR ET AL (US 5,547,761).

MORGAN ET AL discloses a copolymer comprising tetrafluoroethylene (TFE) and a perfluorovinyl ether, wherein the perfluorovinyl ether ends with a -COOH functional group. The copolymer is suitable for coating golf balls and forming golf ball cover layers. (line 10-25, col. 5; line 10-25, col. 8; line 3-13, col. 13) (see corresponding portions of CHAPMAN, JR ET AL)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the copolymer containing a functionalized fluorovinyl ether as a coating and/or cover layer material for golf balls in order to provide a durable protective coating.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over:

(a) MORGAN ET AL (US 5,397,829), or

(b) CHAPMAN, JR ET AL (US 5,547,761),

as applied to claims 1, 5 above,

and further in view of HIGUCHI ET AL (US 5,702,311)

HIGUCHI ET AL discloses that it is well known in the art to use multilayer core structures in the formation of golf balls to optimize the playing characteristics of the ball (Figure 1A-1B; line 35-50, col. 1).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use conventional multilayer construction to form the cores of the coated golf balls disclosed in MORGAN ET AL or CHAPMAN, JR ET AL in order to optimize the mechanical and/or flight characteristics of the ball for various playing styles

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Conclusion


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 27, 2007


Vivian Chen
Primary Examiner
Art Unit 1773